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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,436	02/25/2004	Henry J. McVicker	513779600009	4874

28104 7590 06/14/2005

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EXAMINER
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HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/786,436

Applicant(s)

MCVICKER ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 19-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_

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1. Claim 8 is objected to because of the following informalities: Claim 8 recites "ore" in line 3, which should apparently be "or." Appropriate clarification and correction is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites "the mold cavity" in line 2. There is no antecedent basis for this limitation in this claim, and as such there no relation between the mold cavity and the previously defined insert structures. This renders the claims indefinite.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 and 11-18 rejected under 35 U.S.C. 102(b) as being anticipated by Korsch (U.S. Pat. No. 3,784,344).

Initially it is noted that several of the claims of the instant application recite "means for" clauses. These elements have been interpreted as invoking 35 U.S.C. § 112, sixth paragraph, and thereby are limited to the corresponding structure described in the specification and equivalents thereof. In re Donaldson, 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1950 (Fed. Cir. 1994); MPEP § 2181.

Claim 1 recites a "means for mounting" in line 6. The specification of the instant application discloses a means for mounting as the projections described at ¶ 18, or the retaining surfaces described at ¶ 20

Claim 3 recites a "means for fastening" at line 2. Similarly, claim 10 defines a "means for fastening" at line 2. The specification of the instant application discloses the means for fastening as screws as described at ¶ 18.

Claim 5 recites a "means for providing a substantially smooth surface" at line 1. The specification of the instant application discloses this means as a cap as described at ¶ 19.

Korsch discloses a molding apparatus. The apparatus includes an insert (4) being sized and dimensioned to fit within a recess in the mold (see Figs. 1 and 2). The insert includes a first surface having an area (5) thereon that is a complement of the structural feature to be imparted on the molded article. A means for mounting the insert in recess on the inner surface of the mold is provided. Specifically, the means for mounting includes projections (6) which fit within depressions in the inner surface of the mold cavity (see Fig. 1). The projections comprise apertures for receiving screw fasteners (8) such that the screws are recessed with respect to a front surface of the projections when the insert is placed on the inner surface of the mold (see Fig. 2). Note, this is equivalent to disclosed "means for providing substantially smooth surface" described in the instant application because it functions to provide the same smooth outer surface on the projection, while at the same time fastening the projection to the mold. See In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) (noting a structure can be found to be an equivalent when the structure performs the function specified in the claim in substantially the same manner as the function is performed by the corresponding element described in the specification).

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6. Claims 1, 8-10, 14, 15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Chittenden et al. (U.S. Pat. No. 3,380,121).

Chittenden discloses a mold with replaceable inserts. As shown in Fig. 2, the mold has an inner surface defining a cavity (14) in which a molded article is formed. The inner surface has a recess adapted for receiving a mold insert (16). The mold insert is sized and dimensioned to fit within the recess, and includes a first surface for forming the structural feature on the surface of the molded article (see Figs. 1 and 2).

Chittenden further discloses the mold insert (16) to include a means for mounting in the recess on the inner surface (14) of the mold (see Fig. 2). The means for mounting comprises retaining surfaces and a retaining means (22 and 23) that engages the retaining surfaces (see Fig. 2). More specifically, the retaining surface comprise a shoulder extending from the side of the mold insert, and the retaining means comprises retaining blocks (22 and 23) having surfaces that engages the shoulder (see Fig. 2). The retaining blocks (22) include apertures for receiving a fastening means (24).

7. Claims 19-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

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independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 6 and 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest an insert with the combination of features defined in claim 6 or claim 19. The closest prior art disclosed by Chittenden and Korsch is described above. Chittenden and Korsch fail to teach or suggest a cap that fits within the aperture at the front end of the fastening means as defined in claim 6. Chittenden and Korsch also fail to teach or suggest the insert's surface to comprise a plurality of hook-shaped cavities as defined in claim 19.

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10. The following reference cited but not relied upon is deemed pertinent to the instant application:

Kim et al. (U.S. Pat. No. 6,149,420) discloses a mold with an indicia forming changeable core.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions




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on access to the Private PAIR system, contact the Electronic  
Business Center (EBC) at (866) 217-9197 (toll-free).



Donald Heckenberg  
Patent Examiner  
A.U. 1722

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